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09/895,077

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Thomas V. Johnson

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/895,077

Applicant(s)

JOHNSON ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Response after Final Rejection:

This action is in response to a recognition that the prior Final Rejection (mailed 4/9/04) was not complete and contained an error. Specifically, the prior action stated claims 6-56 were cancelled when in fact they were only withdrawn. Hence, the Finality of the previous office action is hereby withdrawn and the period for response restarted.

Applicant's election with traverse of claims 1-5 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the asserted groupings are not distinct. This is not found persuasive for the reasons given below.

MPEP § 803 states:

Criteria For Restriction between Patentably Distinct Inventions

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05 (i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

Guidelines

Examiners must provide reasons and/or examples to support conclusions but need not cite documents to support the restriction requirement in most cases.

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Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within the meaning of 35 U.S.C. 103, restriction should be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. Insofar as the criteria for restriction practice relating to Markush-type claims is concerned, the criteria is set forth in MPEP § 803.02. Insofar as the criteria for restriction or election practice relating to claims to genus-species, see MPEP § 806.04(a) - § 806.04(i) and § 808.01(a).

Since examiner has shown that undue burden is placed on the examiner due to separate classifications of the independent claims and hence separate searches, and since applicant fails to rebut the restriction by appropriate showings or evidence, the restriction is deemed proper and is maintained and made FINAL.

Claims Status:

Claims pending 1-5

Claims withdrawn 6-52

Claim Rejections - 35 USC § 101

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 101 that form the basis for the rejections under this section made in this Office Action:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The MPEP § 2106, Section ii) Computer-Related Processes Limited to a Practical

Application in the Technological Arts states:

There is always some form of physical transformation within a computer because a computer acts on signals and transforms them during its operation and changes the state of its components during the execution of a process. Even though such a physical transformation occurs within a computer, such activity is not determinative of whether the process is statutory nor determinative of whether the process is statutory because such transformation alone does not distinguish a statutory computer process from a nonstatutory computer process. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036.

Consider claim 1 in light of the above.

Claim 1 recites "creating for the first instance, a reverse link that defines a relationship between the first instance and the association and determining a relationship between the first and second instances based on the reverse link." Claim 1 comprises manipulation of an abstract idea because the practical application of the claimed relationship is difficult to determine.

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Claim 1 recites "creating for the first instance, a reverse link that defines a relationship between the first instance and the association." Above method step defines a relationship which obviously must be fully known at the time of defining. Claim1 further recites "determining a relationship between the first and second instances based on the reverse link." This method step is redundant as the relationship is obviously fully known at the time of defining and thus there is no need to determine a relationship. At best, claim 1 can be characterized as the manipulation of an abstract idea, although even the abstract idea being manipulated is difficult to imagine. Therefore, above method of creating reverse links between objects does not achieve a practical application.

Claims 2-5 are rejected for being dependent from a rejected base claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "determining a relationship between the first and second instances based on the reverse link." In the preamble, applicant claim the first instance of the object and the second instance of the object are associated and then in step 1, a link is established between the

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objects and in step 2, the relationship between the objects is determined. The usefulness of such a circular procedure is suspect. If applicant establishes links based on the association between the objects, why is it necessary to determine the relationship between the objects. Examiner maintains the step “determining a relationship between the first and second instances” is redundant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,862,379 issued to Rubin et al (hereafter Rubin ‘379).

Claim 1:

Rubin ‘379 discloses:

A method for determining a relationship between objects related to a common information model, the objects including at least a first [claim 1, step C, **source object**] and second [claim 1, step E, **destination object**] instance and an association [source object instance of first object class, destination object, instance of second object class], the method comprising:

- creating, for the first instance, a reverse link [claim 1, step G, **linking object**] that defines a relationship between the first instance and the association; and

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- determining a relationship [claim 1, step H, **displaying default events, property settings**] between the first and second instances based on the reverse link.

Claim 2:

Rubin '379 discloses wherein each association reflects a relationship between a respective association and a corresponding associated object [claim 1 step C, E].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubin '379 in view of US Pat No 5,937,189 issued to Branson et al (hereafter Branson '189).

Claim 3:

Rubin '379 discloses the elements of claim 1 as noted above.

Rubin '379 fails to disclose wherein the instance is associated with a first wrapper defining the reverse link.

Branson '189 discloses wherein the instance is associated with a first wrapper defining the reverse link [Fig 12 and col 15, lines 49-65].

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rubin '379 to include wherein the instance is associated with a first wrapper defining the reverse link as taught by Branson '379.

The ordinarily skilled artisan would have been motivated to modify Rubin '379 per the above for the purpose of determining the configuration relationships [col 15, lines 49-65].

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rubin '379 in view of US Pat No 5,133,068 issued to Crus et al (hereafter Crus '068).

Claim 4:

Rubin '379 discloses the elements of claim 1 as noted above.

Rubin '379 fails to disclose defining a pointer in a first table that references a second table; and defining a pointer in the second table that references the instance of the association class.

Crus '068 discloses defining a pointer in a first table that references a second table; and defining a pointer in the second table that references the instance of the association class.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rubin '379 to include defining a pointer in a first table that references a second table; and defining a pointer in the second table that references the instance of the association class as taught by Crus '068.

The ordinarily skilled artisan would have been motivated to modify Rubin '379 per the above for the purpose of providing a relationship descriptor [claim 1].

Claim 5:

The combination of Rubin '370 and Crus '068 discloses wherein determining a relationship includes: collecting a reference reflecting a relationship between the association and the second instance based on the pointer in the second table [Crus '068, claim 1]

Response to Arguments

Applicant's arguments filed 3/16/2004 have been fully considered but they are not persuasive.

First Applicant Argument:

Applicant responds to the rejection under 35 U.S.C. § 112, first paragraph on pages 22-26.

First Examiner Response:

Examiner is not persuaded. In the preamble, applicant states the first instance of the object and the second instance of the object are associated and then in step 1, a link is established between the objects and in step 2, the relationship between the objects is determined. The usefulness of such a circular procedure is suspect. If applicant establishes links based on the association between the objects, why is it necessary to determine the relationship between the objects. Examiner maintains the step "determining a relationship between the first and second instances" is redundant. The rejection under 35 U.S.C. § 112, first paragraph is maintained.

Second Applicant Argument:

Applicant states in the second paragraph on page 29 "To begin with, claim 1 includes recitations that produce 'concrete, tangible and useful' results and, therefore, the claimed invention accomplishes a practical application and is not abstract."

Applicant states in the third paragraph on page 29 “In this case, claim 1 clearly includes processes that produce useful, concrete, and tangible results. For example, the steps of ‘creating, for the first instance, a reverse link ...’ and ‘determining a relationship ...’ set forth in claim 1 produce useful, concrete, and tangible results, such as determining a relationship between [objects] related to a common information model. As discussed in the application at paragraphs 10 and 12-15, determining such relationships has a useful application in the technological arts.”

Second Examiner Response:

Examiner is not persuaded. In the preamble, applicant states the first instance of the object and the second instance of the object are associated and then in step 1, a link is established between the objects and in step 2, the relationship between the objects is determined. The usefulness of such a circular procedure is suspect. If applicant establishes links based on the association between the objects, why is it necessary to determine the relationship between the objects. Examiner maintains the step “determining a relationship between the first and second instances” is redundant. The rejection under MPEP § 2107.01 states:

Deficiencies under the “useful invention” requirement of 35 U.S.C. 101 will arise in one of two forms. The first is where it is not apparent why the invention is “useful.” This can occur when an applicant fails to identify any specific and substantial utility for the invention or fails to disclose enough information about the invention to make its usefulness immediately apparent to those familiar with the technological field of the invention. *Brenner v. Manson*, 383 U.S. 519, 148 USPQ 689 (1966); *In re Ziegler*, 992 F.2d 1197, 26 USPQ2d 1600 (Fed. Cir. 1993). The second type of deficiency arises in the rare instance where an assertion of specific and substantial utility for the invention made by an applicant is not credible.

Specific Utility

A “specific utility” is specific to the subject matter claimed. This contrasts with a general utility that would be applicable to the broad class of the invention. Office personnel should distinguish between situations where an applicant has disclosed a specific use for

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or application of the invention and situations where the applicant merely indicates that the invention may prove useful without identifying with specificity why it is considered useful.

Examiner maintains applicant has failed to provide evidence why instant application would be considered useful to those familiar with the technological field of the invention. Furthermore, applicant states that instant invention has some vague and general utility without proving a specific utility. Applicant does not disclose in what application of the technological arts the claimed method of providing a link between objects is particularly useful. The purpose of providing such a link is difficult to determine. If the purpose is unclear, the usefulness certainly has not been proven.

Examiner concludes that per the following excerpt from MPEP § 2107.01, applicant has failed to rebut examiner's prima facie showing of no specific and substantial credible utility. The rejection under 35 U.S.C. 101 is maintained.

Once a prima facie showing of no specific and substantial credible utility has been properly established, the applicant bears the burden of rebutting it. The applicant can do this by amending the claims, by providing reasoning or arguments, or by providing evidence in the form of a declaration under 37 CFR 1.132 or a patent or a printed publication that rebuts the basis or logic of the prima facie showing. If the applicant responds to the prima facie rejection, the Office personnel should review the original disclosure, any evidence relied upon in establishing the prima facie showing, any claim amendments, and any new reasoning or evidence provided by the applicant in support of an asserted specific and substantial credible utility. It is essential for Office personnel to recognize, fully consider and respond to each substantive element of any response to a rejection based on lack of utility. Only where the totality of the record continues to show that the asserted utility is not specific, substantial, and credible should a rejection based on lack of utility be maintained.

Third Applicant Argument:

Applicant states on page 32 "Accordingly, Rubin et al cannot teach a method for determining a relationship between objects in a common information model, whereby the objects

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include at least a first and second instance, and an association, and the method including, at least, creating for the first instance a reverse link that defines a relationship between the first instance and the association. Contrary, to the examiner's assertions, the 'source object instance of first object class, destination object, instance of second object class' is not an association.'"

Third Examiner Response:

Examiner is not persuaded. Consider the following excerpt from the MPEP:

MPEP § 2106. II.C Review the Claims:

Office personnel must rely on the applicant's disclosure to properly determine the meaning of terms used in the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff'd*, U.S. 116 S. Ct. 1384 (1996). An applicant is entitled to be his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings.").

Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well-known in the art, the applicant does not have to provide a disclosure that describes those elements. In such a case the elements will be construed as encompassing any and every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.

Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPAQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 13201322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonable allow

Applicant does not particularly point to the specification for an explicit definition of the term "an association." Examiner will thus give supra claim limitation its broadest reasonable

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interpretation. Examiner concludes that the 'source object instance of first object class, destination object, instance of second object class' is an association.

Fourth Applicant Argument:

Applicant states in the third paragraph on page 32 "As mentioned, the linking object taught by Rubin et al are not reverse links. According to Rubin et al, the linking objects are placed by a user between the source and destination object. Accordingly, the linking objects do not define a relationship between an association and a first instance. For example, if the examiner's position is that one of the source object or destination object is an association, then the reference does not teach objects including a first and second instance and an association. Further, if the examiner's position is that the linking object is an association, then the reference does not teach a reverse link. And, as explained, because Rubin et al does not teach associations there can be no reverse links that define a relationship between a first instance and an association. Further, Rubin et al cannot teach determining a relationship between the first and second instance^{4s} based on the reverse link because as explained, Rubin et al doe not teach the creation of such links that define a relationship between an instance and an association."

Fourth Examiner Response.

Examiner is not persuaded. Applicant is referred to supra first examiner response.

Fifth Applicant Argument:

Applicant states in the third paragraph of page 34 "Accordingly, contrary to the examiner's statement that all of the recitations of claim 3 are taught by Branson et al, and Rubin et al, these references [do] not teach or suggest an instance being associated with a first wrapper defining the reverse link.

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Fifth Examiner Response:

Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Sixth Applicant Argument:

Applicant states in the third paragraph on page 35 "In this case there is no 'substantial evidence' in the record or in the art to support the attempted combination of Branson et al and Rubin et al., and the requisite 'clear and particular' motivation to support a prima facie case of obviousness is lacking."

Sixth Examiner Response:

Examiner is not persuaded. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rubin et al per the teachings of Branson et al for the purpose of determining configuration relationships.

Seventh Applicant Argument:

On pages 37 and 38, Applicant presents similar arguments to the above regarding the lack of motivation to combine Rubin et al with Crus et al.

Seventh Examiner Response:

Applicant is referred to supra fourth examiner response.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

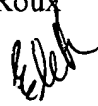
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

5/28/2004 


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100